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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/758,793	01/16/2004	Janis T. Eells	650053.91690	6505	
26710 QUARLES & E	7590 03/09/2003 BRADY LLP	7	. EXAMINER		
411 E. WISCONSIN AVENUE			JOHNSON III, HENRY M		
SUITE 2040 MILWAUKEE	, WI 53202-4497		ART UNIT	PAPER NUMBER	
	•		3739		
SHORTENED STATUTOR	Y PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MO	NTHS	03/09/2007	PAF	PER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	· ·		_ 1/0			
	Application No.	Applicant(s)				
	10/758,793	EELLS ET AL.				
Office Action Summary	Examiner	Art Unit				
	Henry M. Johnson, III	3739				
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	correspondence addre	ess			
A SHORTENED STATUTORY PERIOD FOR REPLY	IS SET TO EXPIRE 3 MONTH	S) OR THIRTY (30)	DAYS.			
WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 16(a). In no event, however, may a reply be tin rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this comn D (35 U.S.C. § 133).				
Status						
1)⊠ Responsive to communication(s) filed on <u>11 De</u>	ecember 2006.					
,-	action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.				
Disposition of Claims						
4) Claim(s) 1-14 is/are pending in the application.						
4a) Of the above claim(s) is/are withdraw	vn from consideration.					
5) Claim(s) is/are allowed.						
6) Claim(s) <u>1-14</u> is/are rejected.						
7) Claim(s) is/are objected to.	r clastian requirement					
8) Claim(s) are subject to restriction and/o	r election requirement.					
Application Papers						
9) The specification is objected to by the Examine						
10) \boxtimes The drawing(s) filed on <u>16 January 2004</u> is/are: a) \boxtimes accepted or b) \square objected to by the Examiner.						
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
The oath of declaration is objected to by the Ex	diffile. Note the attached Office	27.00.011 01 101111 1 1 0	102.			
Priority under 35 U.S.C. § 119						
12) ☐ Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. § 119(a	ı)-(d) or (f).	·			
a) All b) Some * c) None of:						
1. Certified copies of the priority document		ion No				
2. Copies of the certified copies of the priority			age			
·	3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s)						
1) Notice of References Cited (PTO-892)	4) Interview Summar	y (PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08)	Paper No(s)/Mail D					
Paper No(s)/Mail Date	6) Other:					

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Response to Arguments

Applicant's arguments filed December 11, 2006 have been fully considered but they are not persuasive. The evaluation of the method steps is based on the action steps, in this case exposing radiation to a visual component and observing the result. These steps are clearly cited by North et al. Where a reference discloses the terms of the recited method steps, and such steps necessarily result in the desired and recited effect, that the reference does not describe the recited effect *in haec verba* is of no significance as the reference meets the claim under the doctrine of inherency. Ex parte Novitski, 26 USPQ2d 1389, 1390-91 (BdPatApp & Inter 1993). The absence or presence of other steps is not required by the claims as cited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,599,891 to North et al. North et al. teach a method for treating macular edemas using light directed to a retina with a wavelength between 550 and 695 nanometers (Col. 25, line 29) with a fluence from 1-50 J/cm² (Col. 4, line 41). The light may be provided by LEDs (Col. 3, line 16). 50 mW/cm² for 166 seconds is specifically disclosed (Col. 25, lines 10-12). The method may be repeated up to four times (Col. 26, line 51) based on observation of results.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,599,891 to North et al. as applied to claim 1 above, and further in view of Rosner et al., "Dose and Temporal Parameters in Delaying Injured Optic Nerve Degeneration by Low-energy Laser Irradiation," Laser Surgery Med. 13:61 1-617, 1993. North et al. are discussed above, but do not teach 24-hour intervals between treatments. Rosner et al. teach the use of low energy laser radiation to delay the degeneration of injured optic nerves. The wavelength of the He-Ne laser is 632.8 nanometers and the treatments are disclosed as once a day (every 24 hours) for 14 consecutive days (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the treatment intervals as taught by Rosner et al. in the methods of North et al. as both are treating related injury or damage. While neither North et al. nor Rosner et al. teach multiple treatments in a day, it is considered obvious that a skilled artesian would determine the appropriate interval based on knowledge since the applicant's

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disclosure does not place any criticality on the interval and indicates a wide range from several times per day to weekly treatments. It is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. <u>In re Luck</u>, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references. <u>In re Jacoby</u>, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Henry M. Johnson, III Primary Examiner

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